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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,548	12/01/2003	Peter Kight	3350-0106B	7369

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EXAMINER


KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No. 10/608,548	Applicant(s) KIGHT ET AL.	
	Examiner Stefano Karmis	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 3,4,10,11,17 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/4/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following application has been reviewed. Original claims 1-20 are pending. The rejections are as stated below.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119 (e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The instant application is a continuation of application 09/795,314. However significant portions of the specification are different and the applications do not contain the same disclosure. New matter has been added to the instant application. Therefore the claimed priority is invalid. Further, Applicant claims the instant application is a division of 09/034,561 now Patent Number

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6,289,322. This application contains no reference to risk determination as required in the instant application in each of the independent claims and this new matter has been added to the instant application. Therefore, the applications are deemed to have different fields of endeavor and the priority to the divisional application is not considered.

Claim Objections

3. Claims 3, 4, 10, 11, 17 and 18 objected to because of the following informalities: Claims 3, 4, 10, 11, 17 and 18 contain acronyms such as ACH and RPS that must be spelled out in their initial use. For example, in claim 3, “directing an Automated Clearing House (ACH)....” Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 are rejected under 35 U.S.C. 101 as non-statutory. The method claims as presented do not claim a technological basis in the preamble or the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a

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manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim at least one structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

A suggested preamble for claim 1: "A computer implemented method for billing and payment, comprising:" or something similar.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Watson U.S. Patent 5,978,780.

Regarding independent claims 1, 8 and 15, Watson discloses a method for billing and payment comprising:

transmitting, to a plurality of payors, bill information representing a plurality of bills from a plurality of billers to the plurality of payors, including first information representing a

first of the plurality of bills of a first of the plurality of billers for a first of the plurality of payors (column 4, lines 37-54);

receiving a payment instruction from the first payor to pay the first bill based on the transmitted information (column 4, lines 55-67);

determining a risk associated with payment of the first bill (column 4, lines 46-54);

selecting a debit type based upon the determined risk (column 4, lines 55-67);

initiating a payment of the first bill to the first biller based on the received payment instruction and the selected debit type (column 5, lines 1-10).

Claims 2, 9 and 16, the debit type is selected from a group including, debiting a deposit account associated with the first payor and debiting a deposit account associated with a service provider (column 4, line 55 thru column 5, line 32).

Claims 3, 10 and 17, if the debiting of the deposit account associated with the first payor is selected, the payment is initiated by one of (i) directing an ACH crediting to a deposit account associated with the first biller of ACH debited funds from the deposit account associated with the first payor, and (ii) directing preparation of a negotiable instrument payable to the first biller drawn on the deposit account associated with the first payor (column 15, lines 27-60); and if the debiting of the deposit account associated with the service provider is selected, the payment is initiated by one of (i) directing an ACH crediting to the deposit account associated with the first biller of the ACH debited funds from the deposit account associated with the service provider, (ii) directing another type of RPS crediting to the deposit account associated with the first biller

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of debited funds from the deposit account associated with the service provider and (iii) directing preparation of a negotiable instrument payable to the first biller drawn on the deposit account associated with the service provider (column 15, lines 61 thru column 16, lines 17).

Claims 4, 11 and 18, directing the ACH crediting to the deposit account associated with the service provider of other ACH debited funds from the deposit account associated with the first payor, if the debiting of the deposit account associated with the service provider is selected (column 16, lines 52-62).

Claims 5, 12, and 19 the received payment instruction has an associated payment amount; and the risk is determined based on a relationship between the payment amount and a payment amount threshold associated with all of the plurality of payors (column 13, lines 25-67).

Claims 6 and 13, the received payment instruction has an associated payment amount; and the risk is determined based on a relationship between the payment amount and a payment amount threshold associated with one of the first payor and the first biller (column 13, lines 25-67).

Claims 7, 14 and 20, the received payment instruction has an associated payment amount; the payment of the first bill is directed to be made within a time period; and the risk is determined based on a relationship between the payment amount plus a sum of other payment amounts associated with other payment instructions which have been received from the first

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payor for payments within the time period and a payment amount threshold (column 13, lines 25-67).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted
Stefano Karmis
10 January 2005

**VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**

